



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,898	04/12/2001	Kevin L. Payton	10283.3801	2060
22235	7590	12/23/2003		
MALIN HALEY AND DIMAGGIO, PA 1936 S ANDREWS AVENUE FORT LAUDERDALE, FL 33316				
			EXAMINER WILSON, JOHN J	
			ART UNIT 3732	PAPER NUMBER 19
DATE MAILED: 12/23/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/833,898

Applicant(s)

PAYTON, KEVIN L.

Examiner

John J. Wilson

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-10 and 14 is/are allowed.
- 6) ☒ Claim(s) 1, 4-6 and 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeVincenzo et al (5853291). DeVincenzo (291) shows a subperiosteal system comprising a small thin body 66, that is shown in a substantially flat embodiment in Figs. 14, 15, 18 and 19, having apertures for a bone fastener, column 3, line 36, a rigidly attached wire guide 72, column 7, lines 40-49, and a central member connecting the body to the wire guide as shown, Fig. 19. It would be obvious to use plural fasteners in view of the showing of a plurality of apertures. As to claim 13, see malleable, column 1, line 67.

Claims 1 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeVincenzo et al (5853291) in view of DeVincenzo (5938437) and Kanomi et al (5921774). DeVincenzo (291) shows a subperiosteal system comprising a small thin body 66, that is shown in a substantially flat embodiment in Figs. 14, 15, 18 and 19, having apertures for a bone fastener, column 3, line 36, wire guide 72, column 7, lines 40-49, and a central member connecting the body to the wire guide as shown, Fig. 19. DeVincenzo (291) does not show a bendable central member. DeVincenzo (437)

Art Unit: 3732

shows a bendable central member 15, column 3, line 1. It would be obvious to one of ordinary skill in the art to modify DeVincenzo (291) to include a bendable portion as shown by DeVincenzo (437) in order to adjust the device to fit the individual patient in order to apply the desired forces to the teeth. The claim language limiting the size of the fastener to one that anchors the body "securely" to the bone is very broad in scope and depends on the manner and the bone that the device is used with. In view of this, it is held that the anchors shown by DeVincenzo (291) will securely anchor the body and/or that the general size of the anchors are an obvious matter of choice in the degree of a known parameter to the skilled artisan. The size is further held to not be critical as evidenced by the disclosure of the present application which fails to disclose a size for the anchor which will function as claimed. The above combination does not show a bracket that is intended to be used with a tension band. It is well known in the art to attach tension bands to brackets. Kanomi shows a tension band bracket 25, 34. It would be obvious to one of ordinary skill in the art to modify the above combination to include the use of a bracket with tension bands as shown by Kanomi in order to apply the desired forces to the teeth. As to claim 12, DeVincenzo (291) does not show a spring rigidly attached to the appliance for receiving an orthodontic tension band. DeVincenzo (437) shows a prong 3 that is for receiving an elastic thread 10, Fig. 2. It would be obvious to one of ordinary skill in the art to modify DeVincenzo (291) to include using the prong as shown by DeVincenzo (437) in order to apply the desired forces to the teeth.

Art Unit: 3732

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeVincenzo (5853291) in view of Kanomi et al (5921774). DeVincenzo (291) shows a subperiosteal system comprising a small thin body 66, that is shown in a substantially flat embodiment in Figs. 14, 15, 18 and 19, having apertures for a bone fastener, column 3, line 36, wire guide 72, column 7, lines 40-49, and a central member connecting the body to the wire guide as shown, Fig. 19. DeVincenzo does not show a bracket that is intended to be used with a tension band. It is well known in the art to attach tension bands to brackets. Kanomi shows a tension band bracket 25, 34. It would be obvious to one of ordinary skill in the art to modify the above combination to include the use of a bracket with tension bands as shown by Kanomi in order to apply the desired forces to the teeth.

#### ***Allowable Subject Matter***

Claims 7-10 and 14 are allowed.

#### ***Response to Arguments***

Applicant's arguments filed November 12, 2003 have been fully considered but they are not persuasive. Applicant argues that the prior art is a subperiosteal system that works differently from the structure of the present invention. Just as the present invention, the prior art is implanted between the bone and tissue and held by bone fasteners. That the prior art also uses additional structure to encourage overgrowth of bone does not negate the structure that it shows. Applicant has added the language "to

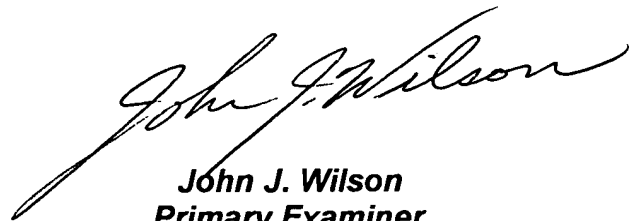
Art Unit: 3732

avoid subperiodontal healing time and ossocointegration for immediate use” and “not utilizing subperiodontal ossocointegration”. These limitations are directed to intended use, and therefore, applicant’s article claims fail to claim any patentable difference in structure, instead, they are directed to the same structure with terminology to imply a different intended use. As such, the actual structure shown is properly met, and the intended use is given no patentable weight. The above combination combines elements that are motivated in view of solving a problem such as a bendable portion or use with brackets and tension bands, all of which would be obvious to use in a method that includes bone integration. Applicant has failed to claim any new or unobvious structure that is specific to and gives life and meaning to the different intended use of not waiting for bone ingrowth or bone overgrowth. Applicant claims fasteners that hold the plate securely, however, there is not structure claimed nor disclosed that differentiates these fasteners from those shown by the prior art. Merely using a known structure in a new manner does not patentable distinguish there over.

Art Unit: 3732

***Conclusion***

Any inquiry concerning this communication should be directed to John Wilson at telephone number (703) 308-2699.

A handwritten signature in black ink, reading "John J. Wilson". The signature is written in a cursive style with a long, sweeping underline.

**John J. Wilson  
Primary Examiner  
Art Unit 3732**

jjw

December 22, 2003

Fax (703) 308-2708

Work Schedule: Monday to Friday – Flex Time